

Customer No.: 31561
Docket No.: 13050-US-PA
Application No.: 10/709,468

REMARKS

Claim Rejections 35 U.S.C. 103

In the current Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Hawker (US Pat. 5,790,679) in view of Dyer (US Pat. 6,688,421).

In response to the rejections to claims 1 and 2, Applicants hereby otherwise traverse these rejections. As such, Applicants submit that claims 1 and 2 are novel and unobvious over Hawker, Dyer, or any of the other cited references, taken alone or in combination, and thus should be allowed.

Addressing claim 1, the Examiner his interpretation of the edge of Dyer to be a sidewall in the current Office Action, in that it is contended "[O]ne of ordinary skill in the art would recognize that a sidewall is an edge, and in this case, the edge of Dyer performs the same function as the sidewall of Applicant's invention with the respect to the retention flaps or positioning slices ..." ("Response to Arguments" section, page 6). Applicants respectfully disagree. As previously submitted Applicants believe that "... an edge is a line or border at which a surface terminates, while a sidewall is presented as a surface being extended, from which the positioning slices are extended ...". Applicants submit the concerned limitation hereby is a structural limitation rather than functional. Therefore, the Examiner can not interpret an edge to be a sidewall simply by alleging that they perform the same function. Whether a sidewall as claimed in the present invention could possibly be taught to one having ordinary skill in the art by the edge should rely on the fact that whether they are they are structurally identical.

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As previously submitted that “an edge is either ‘the cutting side of a blade’, ‘the sharpness of a blade’, ‘the line where an object or area begins or ends’, ‘a point near the beginning or the end’, or ‘a line or line segment that is the intersection of two plane faces (as of a pyramid) or of two planes’, none of which supports the Examiners consumption of ‘[O]ne of ordinary skill in the art would recognize that a sidewall is an edge ...’ (See <http://www.m-w.com/dictionary/edge>). On the contrary, Dyer teaches “a cavity 104 to accommodate at least a part of an audio device” (col. 3, lines 32-33), and “[R]etention flaps 350 protrude from the edges of cavity 104 ...” (col. 4, lines 22-23). When referring to Fig. 3, which is cited by the Examiner for arriving at the present invention, the edge 350 would have been inevitably and clearly understood as having a blade form that is distinct from the sidewall that is required by the claimed invention, as set forth in claim 1.

Further, it is held that “[O]rdinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say” *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). Applicants submit that the edge taught by Dyer with all evidence presented in the specification and drawings could possibly have a structure of a sidewall from which could a slice extend. Since one of ordinary skill in the art clearly knows that a sidewall is so defined because of its planar structural form, while an edge is so defined because of its linear structural form. Distinction existed therebetween is clear and unquestionable. Therefore, while the claimed invention has limited the claimed scope as of the positioning slices extend from a sidewall, it has already excluded the teaching of flaps extending from an edge by Dyer. Similarly, an edge which meaning is clear and unquestionable absent any indication that its use in a particular context changes its meaning should be construed as what it is, rather

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than a sidewall as claimed.

Applicants again submit that rejecting the claimed invention merely by insisting a clearly different item would be considered as same as the claimed subject matter without providing any evidence showing such a comment is reasonable is insufficient and not appropriate.

Still further, in the corresponding "Response to Arguments" section, the Examiner contended: "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art". Applicants agree with the Examiner while obtaining contrary conclusion. Applicants had never argued about whether the primary reference and the secondary reference could be bodily incorporated, and/or the claimed invention must be expressly suggested in any one or all of the references. What was and is being argued is exactly "what the combined teachings of the references would have not suggested" positioning slices extending from a sidewall of the main portion, because since Dyer only teaches a retention flap extending from an edge, there is no teaching or suggestion to modify Hawker to have positioning slices extending from a sidewall.

Since neither common knowledge nor the specification of the cited reference has clearly taught or even implied the edge to be a sidewall, one of ordinary skill in the art would not have been taught to straddle over the gap between these two concepts and consequently arrive at the claimed invention with teachings of Hawker and Dyer.

As such, Applicants submit that claims 1 and 2 are novel and unobvious over Hawker and Dyer, and thus should be allowed.

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In the current Office Action, the Examiner rejected claims 6-8 and 11-13 under 35 U.S.C. 103(a) as being unpatentable over Hawker (US Pat. 5,790,679) in view of Dyer (US Pat. 6,688,421) and Hansson (6,493,456).

In rejecting claims 6 and 11, the Examiner admitted that "Hawker fails to teach ... wherein the rear sound enclosure has an 'L' shaped cross-section comprising a first portion formed extending along the rear cover, and a second portion formed extending perpendicular with the rear cover", while further cited Hansson for teaching the same. The Examiner then contended that "[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Hawker as modified, with the apparatus of Hansson to tune the speaker.

However, reasonable expectation of success is required for obviousness rejection (MPEP § 2142.02). As shown in Fig. 3 of Hawker, the back enclosure is defined by a planer partition 28 with the transducer 20 attached thereon, and the bottom 38. Such a back enclosure can not be reasonably modified to have an "L" shape, namely having a first portion and a second portion perpendicular one to another. Furthermore, doing so would inevitably destroy the principle of operation of Hawker so as to negatively affect the tuning of the speaker.

As such, there is no suggestion found to motivate the proposed modification, and therefore, claims 6 and 11 are novel and unobvious over Hawker and Hansson, or any of the other cited references, taken alone or in combination, and thus should be allowed.

Claims 7, 8, 12 and 13 depend on allowable independent claims 6 and 11, and are thus submitted to be novel and unobvious over Hawker, Dyer, Hansson, and thus should be allowable.

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Claims 9-10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawker in view of Dyer and Hansson as applied to claims 6, and 11, and further in view of Croft (US 2002/0191808).

In response thereto, Applicants submit that claims 9-10, and 14-15 depend on allowable independent claims 6, and 11 respectively, and thus should also be allowable.

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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1, 2, and 4-15 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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